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Paper No. 6

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OCT 28 2002

In re Application of
Guyon, et al.
Application No. 10/057,849
Filed: January 24, 2002
Atty. Dkt. No.: 02331-0161
(42286-267669)
Title: METHODS OF IDENTIFYING
PATTERNS IN BIOLOGICAL SYSTEMS
AND USES THEREOF

OFFICE OF PETITIONS

:
:
: DECISION REFUSING
: STATUS UNDER 37 CFR
: 1.47(b).
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:
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This decision is in response to the petition under 37 CFR 1.47(b), filed October 8, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed January 24, 2002 without an executed oath or declaration and naming Isabelle Guyon and Jason Weston as joint inventors. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed April 8, 2002 requiring, among other items, an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

The instant petition lacks items (1), (2), and (6) set forth above.

As to item (1), petitioner has failed to establish that the inventors received the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the oath or declaration.

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The declaration of Janina A. Malone states that on May 31, 2002, a Declaration and Power of Attorney was forwarded to inventors via electronic mail. Declarant indicates the declaration has not been returned by either inventor.

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventors. Petitioner has presented no evidence that the non-signing inventors were ever presented with a complete copy of the application papers (specification, claims, drawings, oath or declaration) for the instant application.

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventors were sent a complete copy of the application papers and thereafter refused to execute the declaration. A copy of the application papers should be sent to the last known address of the non-signing inventors, or, if the non-signing inventors are represented by counsel, to the address of the non-signing inventors' attorney. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventors receive the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

As to item (2), an acceptable oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. Any renewed petition should be accompanied by a proper oath or declaration wherein the name, address, residence, and citizenship of each inventor is set forth. The declaration should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventor. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. The signature block of the non-signing inventor should remain unexecuted. Petitioner's attention is directed to MPEP 409.03(b) for further guidance.

As to item (6), the petition does not give any indication that status under Rule 47 is necessary to preserve the rights of any particular party or to prevent irreparable damages to any particular party.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents

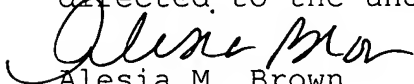
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Telephone inquiries regarding this decision should be
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